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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,272	01/21/2004	Kia Silverbrook	MPA01US	1033

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, NSW 2041
AUSTRALIA

EXAMINER

LEBRON, JANNELLE M

ART UNIT	PAPER NUMBER
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2861

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No.	Applicant(s)	
	10/760,272	SILVERBROOK ET AL.	
	Examiner	Art Unit	
	Jannelle M. Lebron	2861	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/08/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to because Figure 17C is referenced in the specification on page 13 line 16, page 14 line 34, page 17 line 21, page 18 line 11, page 22 line 15, and possibly others. This was already brought to the applicant in the Pre-Exam Formalities Notice mailed 04/26/2004. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 5, and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Silverbrook et al. (US Patent 6,439,908).

4. Regarding claim 1, Silverbrook et al. discloses a printhead module (12) for a printhead assembly, comprising a unitary arrangement of a support member (28), at least two printhead integrated circuits (18), each of which has nozzles (42) formed therein for delivering printing fluid onto the surface of print media, at least one fluid distribution member (26) mounting the at least two printhead integrated circuits to the support member, and an electrical connector (column 3, lines 59-65) for connecting electrical signals to the at least two printhead integrated circuits,

wherein the support member (28) has at least one longitudinally extending channel (72) for carrying the printing fluid for the printhead integrated circuits and includes a plurality of apertures (as shown in figure 8) extending through a wall of the support member arranged so as to direct the printing fluid from the at least one channel to associated nozzles in both, or if more than two, all of the printhead integrated circuits by way of respective ones of the fluid distribution members (column 4, lines 41-44).

5. Regarding claim 2, Silverbrook et al. discloses a printhead module (12) wherein the printhead module (12) is arranged to be removably mounted to the printhead assembly (column 1, line 66 – column 2, line 5).

6. Regarding claim 3, Silverbrook et al. discloses a printhead module (12) wherein the support member (28) is formed with a plurality of the channels (72), each of which is arranged to carry a different printing fluid for direction to associated groups of the nozzles in the both, or if more than two, all of the printhead integrated circuits by way of respective ones of the fluid distribution members (column 2, lines 17-19, lines 59-67).

7. Regarding claim 5, Silverbrook et al. discloses a printhead module (12) wherein the printhead integrated circuits (18) are individually supported upon a separate said fluid distribution member (column 2, lines 17-19).

8. Regarding claim 8, Silverbrook et al. discloses a printhead module wherein a lower surface of the at least one fluid distribution member (26) is attached to the upper surface of the support member (28) by an adhesive material (column 6, lines 14-29).

9. Regarding claim 9, Silverbrook et al. discloses a printhead module wherein the adhesive material is deposited to surround each of the apertures of the support member (28) and each of corresponding apertures formed in the lower surface of the at least one fluid distribution member (26) so as to form a seal between the respective apertures (as shown in figure 8 and 11; column 6, lines 14-40).

10. Regarding claim 10, Silverbrook et al. discloses a printhead module wherein the apertures of the support member (28) are formed in a row extending across the support

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member with respect to the longitudinally extending direction of the support member (as shown in figure 8); and

two deposits of the adhesive material are deposited on either side of the row of apertures to provide stability for the mounting arrangement (column 6, lines 16-20).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook et al. (US Patent 6,439,908) in view of Silverbrook (WO 2001/089849).

Silverbrook et al. meets the claimed limitations as set forth above in claim 1, except "a support member formed with a further channel (82) for delivering air to the at

least two printhead integrated circuits for maintaining the nozzles of the at least two printhead integrated circuits substantially free from impurities.”

Silverbrook teaches an ink distribution structure that supplies air to each print chip (27) via an air inlet port (61) thus preventing the build-up of any dust or unwanted contaminants at the apertures (44) in the nozzle guard (page 7, lines 5-9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a channel for delivering air to the printhead circuits. One would have been motivated to modify the invention to improve print quality as taught by Silverbrook.

14. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook et al. (US Patent 6,439,908) in view of Lu et al. (US 2003/0007042).

Silverbrook et al. teaches a sealing adhesive; however, it does not disclose the sealing adhesive being a curable resin.

Lu et al. discloses a sealing adhesive being a epoxy, a type of resin (paragraph 0017).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Silverbrook et al. with that of Lu et al. in order to create a more durable apparatus.

Double Patenting

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 1-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/760,182. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 8 of the instant application are contained in claims 1 and 2 of the reference application, and thus claims 2-7 and 9-11 of the instant application are the same as claims 6-11 and 3-5 of the referenced application, respectively.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

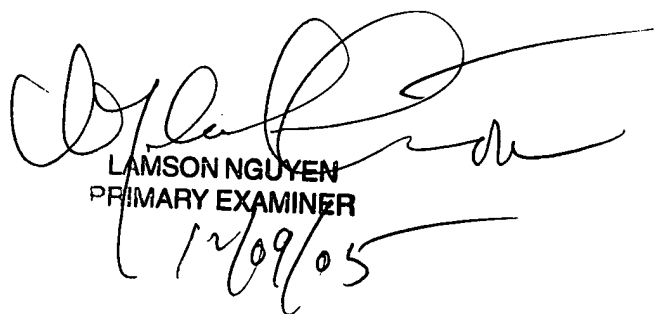
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jannelle M. Lebron whose telephone number is (571) 272-2729. The examiner can normally be reached on Monday thru Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on (571) 272-1934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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12/09/05


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PRIMARY EXAMINER
12/09/05